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APPLICATION NO. FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO. 09/581,044 06/08/00 LEE Т TSRI609.1 **EXAMINER** HM12/0723 THE SCRIPPS RESEARCH INSTITUTE RUSSEL, J 10550 NORTH TORREY PINES ROAD **ART UNIT** PAPER NUMBER MAIL DROP TEC 8 LA JOLLA CA 92037 1653 DATE MAILED: 07/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION I	10. FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
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1		i .		EXAMINER
			ART UNIT	PAPER NUMBER
			DATE MAILED:	9
	Notice of Non	-Compliant Amendment (37		•
the format requir	ed under 37 CFR 1.121,	as amended on September 8, 2000 (see 65 Fed.	Reg. 54603, Sept. 8	, 2000, and
1. The 37 CFF	amendment does not incl 8 1.121(b)(1)(ii).	ude a clean version of the replacement paragra	ence) aph(s)/section(s).	
2. The 37 CFF	amendment does not incl 1.121(b)(1)(iii)	ude a marked-up version of the replacement pa	equence) ragraph(s)/section	(s) .
3. The	amendment does not incl	ude a clean version of the amended claim(s). 3	7 CFR 1.121(c)(1)(i	
4. The	4. The amendment does not include a marked-up version of the amended claim(s). 37 CFR 1.121(c)(1)(ii)			
5. Othe	r <u>.</u>			
with re may co	evised 37 CFR 1.121 wommence without entry	ENT: Unless applicant re-submits the prelinithin ONE MONTH of the mail date of this of the originally proposed preliminary amound this ONE MONTH time limit is not ext	letter, examination	on on the merits
<i>fide</i> , ap date of	oplicant is given a TIM this notice, whichever bandonment. EXTEN	N-FINAL ACTION: Since the above ment IE PERIOD of ONE (1) MONTH or THIR is longer, within which to supply the omiss ISIONS OF THIS TIME PERIOD MAY BE	TY (30) DAYS fision or correction	rom the mailing in order to
MPEP Bool		d to this correspondence is a copy of "Simplified Amendment Practice"		ional flyer

Changes to the Patent Rules

October 20, 2000

Volume 1, Issue 3

This is the third in a series of Patent News Bulletins to assist you in keeping up to date with significant rule changes which affect your area. Keep this copy to use as a bookmark for your present MPEP, or view this bulletin again on the USPTO Website.



Simplified Amendment Practice. Replacement paragraphs/sections/claims to be used. 37 CFR 1.121

The rule package "Changes to the Patent Business Goals - Final Rule," published in the Federal Register on September 8, 2000, 65 Fed. Reg. 54603 (Sept. 8, 2000), and the Official Gazette on September 19, 2000, 1238 Off. Gaz. Pat. Office 77 (September 19, 2000). The PBG rule package makes a number of revisions to Title 37.

The entire final rule may be found at the USPTO Website at http:// www.uspto.gov/web/ offices/dcom/olia/pbg/ index.html.

Areas and individuals primarily affected by this rule change include: (1)Patent Examiners and Tech Support Staff in the Technology Centers (2) Office of Patent Publication

Any questions related to this change in practice should be directed to Joe Narcavage, Special Projects Exr., (703-305-1795) or Liz. Dougherty, Legal Advisor, (703-306-3156) OPLA.

Mandatory compliance with the revised rule is not required until March 1, 2001. It is suggested that applicants adopt the revised procedures on or after November 7, 2000, in order to adjust to the changes in amendment practice.

Under the new amendment practice, amendments to the specification must be made by the submission of clean new or replacement paragraph(s), section(s), specification, or claim(s). This practice will provide a specification (including claims) in clean, or substantially clean, form that can be effectively captured and converted by optical character recognition (OCR) scanning during the patent printing pro-

The new practice requires applicant to provide, in addition to the clean version of a replacement paragraph/section/claim, a marked-up version using applicant's choice of a conventional

marking system to indicate the changes, which will aid the examiner in identifying the changes that have been made. The marked-up version must be based on the previous version and indicate (by markings) how the previous version has been modified to produce the clean version submitted in the current amendment. The term "previous version" means the version of record in the application as originally filed or from a previously entered amendment.

The following format is suggested in an amendment paper: (1) a clean version of each replacement paragraph/section/claim with clear instructions for entry; (2) starting on a separate page, any remarks/arguments (37 CFR 1.111); and (3) starting on a separate page, a marked-up

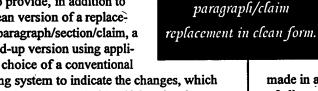
version entitled "Version with markings to show changes made."

Applicants will also be able to submit a clean set of all pending claims, consolidating all previous versions of pending claims from a series of separate amendments into a single clean version in a single amendment paper. This submission of a clean version of all of the pending claims will be construed as directing the cancellation of all previous versions of any pending claims. No marked-up version will be required to accompany the clean version where no changes other than the consolidation are being made.

> The amended rule encourages issuance of applications with an examiner's amendment without practitioners/applicants having to file a formal amendment. Additions or deletions of subject matter in the specification, including the claims, may continue to be

made in an examiner's amendment at the time of allowance by instructions to make any change at a precise location in the specification or the claims. An examiner's amendment may incorporate a printed copy of a fax or email amendment submitted by applicant. Only that part of the e-mail or fax directed to a clean version, or a portion of, a paragraph/ claim to be added should be printed and attached to the examiner's amendment, with a paper copy of the entire e-mail or fax being entered in the file. The electronic version of the e-mail is not required to be saved once the printed e-mail (and any attachments) becomes part of the application file record.

MPEP 714+ & 1302.04



Amendment by

